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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,271	10/20/2000	Donald C. Mann	ULT-001-1	7503
22888 7590 01/28/2008 BEVER HOFFMAN & HARMS, LLP TRI-VALLEY OFFICE 1432 CONCANNON BLVD., BLDG. G LIVERMORE, CA 94550			EXAMINER WALSH, DANIEL I	
			ART UNIT 2887	PAPER NUMBER
			MAIL DATE 01/28/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/693,271

**Applicant(s)**

MANN ET AL.

**Examiner**

Daniel I. Walsh

**Art Unit**

2887

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-10,16,17,19,21-30,38 and 47-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-10,16,17,19,21-30,38 and 47-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of the Terminal Disclaimer received on 12-26-07.

#### ***Claim Objections***

1. Claims 1, 10, 37, and 48-50 are objected to because of the following informalities: Re claims 1 and 10, it appears that the limitations are drawn to the card, not the data storage device of the card. For example, it appears that "said data storage device" on 6 of claim 1 should be replaced with -- said portable card --.

Re claims 37 and 48-50, these claims refer to a thin film layer of claim 10, but claim 10 does not have a thin film layer. For purposes of Examination, the Examiner just interpreted the claims to depend on the coatings of claim 10.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 4-10, 16-17, 19, 21-25, 27-28, 30, and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (US 2001/0052543) in view of Wood (US 5,041,922).

Re claim 1, Liu teaches a portable card adapted to be used in a card processing system having a data processing station comprising a data storage device adapted to interact with the data processing station when the portable processing station and card are moved relative to each other, a substrate having a generally rectangular shape, and magnetic material for storing signals disposed on an arcuate shaped track (FIG. 2d+). Though silent to high density/high coercivity material, it would have been obvious to one of ordinary skill in the art to use such a material, for its known benefits for increased data storage.

Liu is silent to the protective coating as claimed.

Wood teaches magnetic storage for a disc/tape/etc. (interpreted as suitable for a card) and the protective coating having the claimed high density high coercivity material and the protective coating having a magnetically permeable magnetically saturable material (abstract), where the Examiner has interested both layers as forming the protective layer (13,14 form a protective layer). Though silent to being hard and abradable, a protective coating would obviously meet such limitations in order to further protect the card. The Examiner notes that the language regarding the selection of the thickness of the layer is not germane to the patentability of the device itself, and the prior art is interpreted to meet the structural limitations. Regardless,

it would have been obvious to one of ordinary skill in the art to have a thickness that is not too thick to prevent signals but not too thin to be worn off, in order for the card and processing station to function, such selection of a range, where the general conditions of a claim are disclosed by the prior art, involves only routine skill in the art.

Re claims 4-9, the Examiner notes that such limitations regarding the orientation and number of tracks is believed to be taught by Liu, where the tracks are interpreted to extend between the sides, are enclosed by the card and hence extend or are located centrally as claimed, and also Liu teaches the shape of the card, which is conventional in the art.

Re claims 10 and 16-17, the limitations have been discussed above.

Re claim 19, though the film 13 of Wood et al. is silent to being thin, the Examiner notes that it is taught as being plated or sputtered. Therefore, it would have been obvious for such methods to produce a thin film. One would have been motivated to have a thin film, for reduction in size/cost and the use of common manufacturing techniques.

Re claim 21, though silent to a non-magnetic friction reducing layer on one of the layers, the Examiner notes that cards are finished to have a smooth/non magnetic friction reducing layer to effect ease of use of the card, looks, and transporting it through a reader, and therefore such modification is an obvious expedient for such expected results. Such a layer can be interpreted as part of a protection layer as it imparts some protection inherently to the card.

Re claim 22, the Examiner notes that cards are interpreted as cleanable.

Re claim 23, a substrate is understood to have two surfaces, and as such, the protecting coating is therefore applied to one of them (directly or indirectly).

Re claims 24-25, though silent to a recording medium on both sides (which would necessitate the protection layer on both sides and hence meet the limitations), the Examiner notes those cards with magnetic storage on both sides are well known and conventional in the art. One would have been motivated to have such a card for increased data storage, to make orientation easier when reading, and to possibly store more than one account on a card.

Re claims 27-28 and 30, Wood teaches such limitations (claim 16 and FIG. 1), and it is conventional in the art for relative movement to enable data flow, such as conventional readers/cards employ.

Re claim 47-48, Wood teaches sputtering, as discussed above, as a means to easily form a thin layer. Though silent to plating, the Examiner notes plating is also a well known means to form a layer, and hence an obvious expedient to one of ordinary skill in the art to form a magnetic thin layer.

3. Claim 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu/Wood, as discussed above, in view of Hirasawa (US 6,250,552).

The teachings of Liu/Wood have been discussed above.

Liu/Wood are silent to the coating on both surfaces.

Hirasawa teaches magnetic cards can have magnetic storage on both sides (col 1, lines 30+). Accordingly, it would have been obvious to have the coating on both surfaces when both surfaces have a recording medium.

At the time the invention was made it would have been obvious to combine the teachings of Liu/Wood with those of Hirasawa.

One would have been motivated to do this to have a card that does not require such precise orientation (can be inserted either way into a reader since a magnetic storage is on both sides) or one that can have increased data storage, as some cards with dual storage can be linked to separate accounts.

Though Hirasawa teaches stripes, it is believed to be applicable to other track orientations, including rings/arcuate surfaces as the same principles are believed to apply.

4. Claim 26 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu/Wood, as discussed above, in view of Bajorek (US 6,482,330).

The teachings of Liu/Wood have been discussed above.

Liu/Wood are silent to a bonded lubricant layer formed on the outer surface having a thickness less than the protective coating.

Film layers are known in the art for increasing density and providing relief from size (excess). Bajorek teaches a lubricant provided to the protective overcoat (col 4, lines 52+).

Though silent to the thickness, the Examiner notes it would have been obvious to be thinner than the protective layer as the lubricant is employed for reduced friction surface and as being able to be applied by wiping onto the protective layer it would obviously be thinner than a multipart protective layer with magnetic properties. The selection of an optimum value/range when general teaches are taught by the prior art, is within the ordinary skill in the art. Such a layer can be interpreted as a protective component.

Re claim 49, Liu/Wood are silent to oxide layers.

Bajorek teaches such limitations (col 1, lines 15+).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Liu/Wood with those of Bajorek for data storing ease.

5. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu/Wood, as discussed above, in view of Mizoguchi et al. (US 5,689,105).

The teachings of Liu/Wood have been discussed above.

Liu/Wood are silent to the station moving relative to the substrate/card.

Mizoguchi et al. teaches such limitations (abstract).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Liu/Wood with those of Mizoguchi et al.

One would have been motivated to do this to have an alternative means to read the card, and to accurately process with the card (with conformity).

6. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu/Wood, as discussed above, in view of Nishiyama et al. (US 5,721,942)

The teachings of Liu/Wood have been discussed above.

Liu/Wood are silent to the claimed density range.

Nishiyama et al. teaches such a range (claim 4)

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Liu/Wood with those of Nishiyama et al. in order for increased storage capacity.

7. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu/Wood, as discussed above, in view of Meeks (US 6,268,919).

The teachings of Liu/Wood have been discussed above.



Liu/Wood are silent to the plating.

Meeks teaches such limitations (col 1, lines 43-50).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Liu/Wood with those of Meeks since plating is well known and conventional for disks/drives to lead to desired properties for magnetic surfaces.

8. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu/Wood, as discussed above, in view of Foley (US 4,518,627).

The teachings of Liu/Wood have been discussed above.

Liu/Wood are silent to the web coating.

Foley teaches such limitations (col 3, lines 15-35 and abstract).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Liu/Wood with those of Foley.

One would have been motivated to do this to produce a durable magnetic medium, as is commonly done in the art.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See PTO-892).

2. Applicant's amendment (5-21-07) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Paik can be reached on (571) 272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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D, Walsh

Daniel I Walsh  
Examiner  
Art Unit 2887

A handwritten signature in black ink, appearing to read 'D. Walsh', with a long vertical line extending downwards from the end of the signature.

DANIEL WALSH  
PRIMARY EXAMINER